



Docket No.: PC-0041 CIP.

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By: Margaret M. Hasson Printed: Margaret M. Hasson

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Yue et al.

Title: PROGESTERONE RECEPTOR COMPLEX P23-LIKE PROTEIN

Serial No.: 09/867,958

Filing Date:

May 29, 2001

Examiner: Nolan, P.

Group Art Unit:

1644

**Box Non-Fee Amendment**

Commissioner for Patents

Washington, D.C. 20231

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**RESPONSE TO RESTRICTION REQUIREMENT UNDER 35 U.S.C. 121**

Sir:

This paper is responsive to the Restriction Requirement and Request for Election dated December 13, 2002, setting a one (1) month term for response.

**Restriction Requirement**

In the Restriction Requirement, the Examiner cited Applicants previous election of Group I (claims 1-6), with traverse, filed on October 2, 2002. The Examiner noted that the claims of Group I recite a "multitude" of nucleic acid sequences (SEQ ID Nos: 2-8) constituting a recitation of an implied, mis-joined Markush group that contain multiple independent and distinct members. Each of the nucleic acid is independent and distinct because no common structural or functional properties are shared. The Examiner therefore has required Applicant to elect a single nucleic acid sequence from claims 1-6 as constituting independent and distinct inventions.

Applicants hereby elect, with traverse, SEQ ID NO:2 encoding SEQ ID NO:1.

The Examiner is reminded that proper restriction requires the following two conditions be met according to MPEP 803:

**Restriction-When Proper:**

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP Section 802.01 Section 806.04, Section 808.01) or distinct as claimed (see MPEP Section 806.05 - Section 806.05(i)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP Section 803.02 Section 806.04(a) - Section 806.04(i), Section 808.01(a), and Section 808.02). (Emphasis added).

While patentable distinctiveness may have been established for some of the sequences recited the Examiner has clearly not established that there would be a serious burden of search in examining all of the recited sequences. SEQ ID NOs:3-6 are disclosed in the specification as component fragments of SEQ ID NO:2 (see p. 9, lines 17-22) and obviously therefore each share a common structural property with SEQ ID NO:2, contrary to the Examiner's contention. Furthermore, SEQ ID NOs:7 and 8 are also disclosed in the specification (see p. 10, lines 11-20) as sharing almost 90% sequence identity with a portion of SEQ ID NO:2 and would therefore also be found in a single search for sequences related to SEQ ID NO:2

Applicants therefore request reconsideration of the Restriction Requirement and examination of all sequences recited in claims 1-6. In the event the Examiner maintains the Restriction Requirement, Applicants reserve the right to prosecute the subject matter of non-elected claims in subsequent divisional applications.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. 09-0108.

Respectfully submitted,

INCYTE GENOMICS, INC.

Date:

January 9, 2003

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